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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,639	03/17/2004	Tetsuo Kawano	Q80515	1688
23373	7590	09/07/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER NGUYEN, CAM N	
			ART UNIT 1754	PAPER NUMBER
			MAIL DATE 09/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,639

Applicant(s)

KAWANO ET AL.

Examiner

Cam N. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/08/07 (an amendment/response).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment and remarks, filed on June 08, 2007, has been made of record and entered. Claim 1 has been amended.

Claims 1-18 are currently pending in the application.

Status of Withdrawn Claim(s)

2. This application contains claims 8-18 which drawn to an invention nonelected with traverse in Paper No. dated December 29, 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102(b)/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ying et al., "hereinafter Ying", (US Pat. 6,028,025).

Ying discloses a catalyst comprising: an article having an inorganic surface, the surface including an oxide of a transition metal; and a porphyrin including a catalytic metal atom capable of catalyzing an oxidation reaction of a reactant and an oxidant provided to the catalytic metal atom, etc. (see col. 17, claim 1). The article is a porous inorganic article (see col. 17, claim 5). The inorganic article can be any inorganic structure, such as a ceramic including silica, alumina, various transition metal oxides, and the like. Preferred are those inorganic articles that self-assembled as hexagonally-packed or cubic-packed mesoporous (pore size from about 10 Å to about 200 Å, i.e., 1 to 20 nm) materials, etc. (see col. 5, ln 63- col. 6, ln 3). Ying further discloses that the article having an inorganic surface comprises a solid phase structure, etc. (see col. 17, claim 8).

There is no patentable distinction seen between the claimed porous ceramic material and that disclosed by Ying, thus the claims are anticipated by the teaching of the reference.

Product-by-process limitations in the claims are noted. While the product of the reference is not made by the same process, the product made is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, the process limitations in the claims have no bearing on the patentability of the claimed product. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP* 2113.

Claim Rejections - 35 USC § 102(e)/103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 & 7 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McGrath et al., "hereinafter McGrath", (US Pat. 6,638,885).

McGrath discloses a mesoporous ceramic fiber having a pore size diameter in the range of about 10-100 nanometers (see col. 16, claim 1). The ceramic precursor is a salt or alkoxide of titanium (see col. 16, claim 4).

There is no patentable distinction seen between the claimed porous ceramic material and that disclosed by McGrath, thus the claims are anticipated by the teaching of the reference.

Product-by-process limitations in the claims are noted. While the product of the reference is not made by the same process, the product made is the same as being claimed. It has been held that the patentability of the product and its method of production are separately determined. Thus, the process limitations in the claims have no bearing on the patentability of the claimed product. See *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985); *In re Brown*, 173 USPQ 688, 688 (CCPA 1977); *In re Fessman*, 180 USPQ 324, 326 (CCPA 1977). See also *MPEP* 2113.

Response to Applicants' Arguments

7. Applicants' response filed on June 08, 2007 has been fully considered, but not deemed persuasive for the following reasons.

First, applicants urged, that "Ying does not disclose that the catalyst has a fibrous structure" is noted. This is not found persuasive because Ying specifically teaches that the article having an inorganic surface, which comprises a solid phase structure, etc., which structure includes a plurality of essentially tubular pores having a length to diameter ... (see col. 17, claims 1, 8, & 16 of the Ying reference). The "plurality of essentially tubular pores having a length and diameter" is clearly the description of the fiber structures or the fiber materials. The disclosed catalyst clearly has a fibrous structure and it is not seen patentably distinguish from the claimed porous ceramic material.

Second, applicants urged, that "McGrath does not correspond to the presently claimed porous ceramic material..." is also noted. It is also not found persuasive because McGrath clearly teaches a mesoporous ceramic fiber structure having the claimed pore diameters. The

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claimed porous ceramic material does not appear patentably distinguish from the disclosed fiber structure.

It is considered the applied prior art references are still applicable, thus the rejections are maintained.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Claims 1-18 are pending. Claims 1-7 are rejected. Claims 8-18 remain withdrawn due to nonelected (distinct) invention(s). No claims are allowed.

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Contacts

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M-F, 9:00 AM - 6:30 PM, at alternative work site.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cam N. Nguyen/

Nguyen/cnn

Primary Examiner

August 28, 2007

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